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EXAMINER

NGHIEM, MICHAEL P

ART UNIT

PAPER NUMBER

2863

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/773,054
Filing Date: January 31, 2001
Appellant(s): ECKARD ET AL.

MAILED

FEB 8 2005

GROUP 2800

Larry Roberts
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on December 9, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 9, 21, and 34-44 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 12 and 25 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

US 6,042,216	Garcia et al.	3-2000
US 6,250,736	Wojcik	6-2001

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 9, 21, and 34-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Garcia et al. (US 6,042,216).

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art

under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claims 9, 21, 34, 36, 40, and 41, Garcia et al. discloses a method and system (via 230, Fig. 14's) for servicing an inkjet printer (Figs. 1, 16) including an inkjet printhead (106) with a nozzle plate (Fig. 4) and a first service module (wiper 234 or capper 236) removably installed on the printer (Fig. 23), comprising:

- identifying a printhead-related service condition (Abstract, lines 3-6) not adequately addressed by servicing the printer with the first service module being in an un-worn condition (complete servicing includes other service module such as a capper, a spittoon, and primer connection, Abstract, lines 6-8);

- providing a second service module (capper 236 or wiper 234) with a service function different from the first service module (Fig. 14a) and adapted to address said printhead-related service condition, the second service module removably installable on the printer and with respect to the first service module (Fig. 23);

- providing the second service module to the printer user (234, 236 is available for use, Fig. 23), wherein the step of providing a set of instructions includes providing a set of human-readable instructions for using the second service module (column 6, line 61 - column 7, line 7, column 8 line 7-18 provide human-readable instructions on how to use the second service module 234, 236).

Regarding claim 35, Garcia et al. discloses providing the second service module to the printer user (234, 236 are available for use, Fig. 23).

Regarding claim 37, Garcia et al. discloses removing the first service module from the printer (by removing service module, column 8, lines 65-67), installing the second service module in the printer (by replacing with new service module, column 8, line 67), and using the set of instructions and the second service module, conducting a special servicing operation (column 8, lines 63-64).

Regarding claims 38 and 42, Garcia et al. discloses that said printhead-related service condition comprises fibers (dust or particle fibers) accumulating on the printhead nozzle plate (Abstract, lines 3-6, and wherein the second service module includes a brush (wiper 234) to remove the fibers.

Regarding claims 39 and 43, Garcia et al. discloses that said printhead-related service condition includes ink accumulation on the nozzle plate (Abstract, lines 3-6), and wherein the second service module includes a wiper (wiper 234) or applicator having applied thereto a cleaning fluid for removing the ink accumulation (Abstract, lines 3-7).

Regarding claim 44, Garcia et al. discloses that said printhead-related service

condition includes global depriming of the printhead or ink starvation of the printhead (well-known problem due to unclean printhead), and wherein the second service module includes a negative pressure primer (240).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garcia et al. in view of Wojcik (US 6,250,736).

Garcia et al. does not disclose that the second service module includes a wiper fabricated of silicon, or a textile, or a special rubber for removing the ink accumulation.

Nevertheless, Wojcik discloses a wiper (26) fabricated of silicon or rubber (column 3, lines 5-11) for the purpose of providing a compliant and durable wiper.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide Garcia et al. with a silicon or rubber wiper as disclosed by Wojcik for the purpose of providing a compliant and durable wiper.

(11) Response to Argument

1. With respect to the 35 USC 102 rejections, Appellants argue that Fig. 23 is an exploded isometric view of the service station module of Figs. 14A-14B. There is no teaching or description that a wiper 234 is removably installable with respect to a capper 236. Just because the elements of the service module of FIGS. 14A-14B are shown in an exploded view to show details of the service module in a patent application does not support the Examiner's assertion that elements 234 or 236 are intended to be removably installable with respect to the service module or the other elements (page 6, paragraph 5).

Examiner's position is that "the second service module **removably installable** on the printer" merely recites a capability of the second service module. Fig. 23 clearly shows that the wiper (234) and the capper (236) are two separate parts being assembled into a top plate (380). Thus, any person skilled in the art would conclude that inasmuch as the wiper (234) and the capper (236) are capable of being installed onto the top plate (380), they are also capable of being removed from the top plate (380) (reverse of the installation steps).

Wiper (234) fits into holes of (378) (see Fig. 14a). In Fig. 23, any person skilled in the art would know how to remove the wiper (234) from the top plate (380) by disengaging the

blades from the holes of (378). On the other hand, capper (236) is fastened into the top plate (380). Fig. 14a shows the fastener and Fig. 23 shows the fastener holes. Thus, any person skilled in the art would know that the capper (236) is capable of being removed from the top plate (380) by removing the associated fastener.

Appellants further argue that there is no screw (or fastener) specifically illustrated, nor is there any written description supporting the speculation. Instead, Garcia describes that the service module (230) shown in Fig. 14a is "removed and replaced at the same time that the associated printhead is removed" (page 7, paragraph 1).

Examiner's position is that the fastener is illustrated in Fig. 14a. As discussed above, Figs. 14a and 23 supports the feature of the second service module (wiper 234 or capper 236) "removably installable" on the printer with respect to the other service module. Even though Garcia describes that the service module can be removed and replaced at the same time that the associated printhead is removed, nothing is found in the Garcia description that would prevent the wiper (234) or the capper (236) from the capability of being "removably installable" on the printer with respect to the other service module.

Appellants further argue that there is no showing in Garcia that the alleged instructions are provided to the printer user, i.e., the Garcia document is provided to the printer user.

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There is no description of how the user can or should use a "module" (234) or (236) (page 7, paragraphs 2-3).

Examiner's position is that the disclosure of an invention in a US Patent (including Garcia) is intended for any person skilled in the art to make use of the invention. Under 35 USC 112, first paragraph, the "specification shall contain a written description of the invention, and of the manner and process of making and **using it**, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and **use the same** and shall set forth the best mode contemplated by the inventor of carrying out his invention".

The human-readable instructions for using the cap 236 are found in Garcia. Here is the text information from Garcia:

with a nozzle plate cap 236 at an intermediate position. An external primer port 240 in the module is connected through an interior passage to the cap 236, and in the opposite direction through a circular seal 242 to a vacuum source. A

(column 7, lines 1-4)

The human-readable instructions for using the wiper 234 are also found in Garcia. Here is the text information from Garcia:

top plate with the help of a mounting tab 381, and both wipers 234 are incorporated in a single unitary part also mounted on the top plate. A drain 378 next to the wipers feeds ink from the wipers into a waste chamber 379 located in the body portion.

(column 8, lines 14-18)

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The patent of Garcia (US 6,042,216) per se is the human-readable instructions for using the second service module (234, 236).

Any person skilled in the art would conclude that a person who uses the invention of a printhead service module (230) is also a printer user because the service module is part of an inkjet printing system (Abstract, lines 1-2).

Appellants further argue that Garcia does not describe the limitations of Figs. 9, 21, 34, and 40 (page 7, paragraph 4).

Examiner's position is that Garcia discloses the limitations of Figs. 9, 21, 34, and 40 as discussed above (please refer to the above 35 USC 102 rejections regarding the claims).

Appellants argue that Garcia does not describe that the new service module is different from the first service module and adapted to address a printhead-related service condition not adequately addressed by servicing the first module being in an un-worn condition (page 9, paragraph 4).

Examiner's position is that the new service module (236) is different from the first service module (234) and adapted to address a printhead-related service condition (condition wherein printhead needs suctioning by capper 236) not adequately

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addressed by servicing the first module (wiper 234 cannot perform suctioning) being in an un-worn condition (wiper 234 is in an un-worn condition).

With respect to the 35 USC 103 rejections, Appellants argue that the Primary Examiner has not established prima facie that the claimed invention would have been obvious in view of the applied references, and that the references do not teach or suggest the claimed invention (page 11, paragraph 3).

Examiner's position is that it would have been obvious to provide Garcia with a wiper (26) fabricated of silicon or rubber as disclosed by Wojcik for the purpose of providing a compliant and durable wiper (column 3, lines 5-11). (Please see the 35 USC 103 rejections discussed above).

Appellants further argue that Wojcik is cited only for its disclosure of a wiper of silicon or rubber, and does not supply any missing teachings discussed above regarding Garcia (page 12, paragraph 2).

Examiner's position is that Garcia discloses all the claimed limitations of the invention as discussed above except for a wiper fabricated of silicon, textile, or special rubber, which is disclosed by Wojcik.

(12) Additional Remarks

Is the US patent "itself" human readable use instructions?

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The answer is "Yes". The US patent is available, free of charge, to the public domain, including any person skilled in the art (e.g. printer users) to make and use the invention. It contains human readable instructions of the manner and process of making and using the invention.

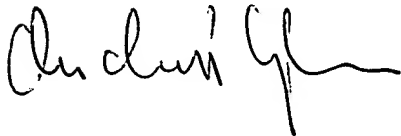
During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

Appellant claims "providing a set of human-readable instructions for using the second service module". The term "using" is broad in scope. According to the "Merriam Webster's Collegiate Dictionary", tenth edition, 1997, the term "to use" is defined as "to put into action or service; to employ; to carry out a purpose or action". Thus, "using" (the second service module) is not necessarily limited to the steps taken to install or remove the second service module.

Further, "providing" a set of human-readable use instructions does not limit the instructions to be packaged in a certain way (manual, tape, floppy-disk, cd-rom, internet, etc...).

(13) Conclusion

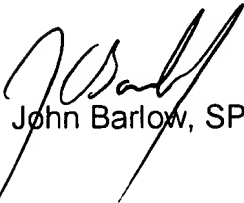
For the above reasons, it is believed that the rejections should be sustained.



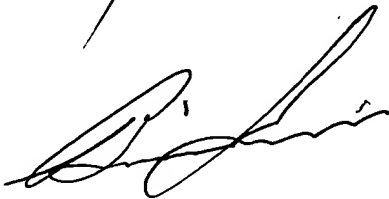
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Respectfully submitted,

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